

## REMARKS

### **I. REJECTION OF CLAIMS 1, 2, 4, 10-12, 14-18 AND 20 AS AMENDED UNDER 35 U.S.C. § 102 IS IMPROPER**

The Examiner rejected Claims 1, 2, 4, 10-12, 14-18, and 20 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent 5,543,788 to Vatt et al. (hereafter “Vatt ‘788”). The Applicant has amended independent Claims 1 and 14, and the dependent claims 15, 18, and 19. Applicant respectfully contends that this reference does not disclose, teach, or suggest the claimed features as suggested by the Examiner for the claims as amended. Specific claimed features as amended are not disclosed, taught, or suggested in the cited art reference. Accordingly, the Applicant respectfully suggests that the Examiner’s rejection based on by Vatt ‘788 should be overcome by the present remarks.

Independent Claims 1 and 14 have been amended to add additional limitations that further distinguish the invention from the cited prior art. The software client operates on a second communication device to imitate the communication protocol on the first communication device, which has a simplex communication protocol operated on the first communication network and a first communication device. The software client configures the communication device, even though not designed or programmed for simplex communication, to imitate a simplex communication protocol operated on the first communication device. *See Application, p. 9-11.* Because Vatt ‘788 fails to suggest, teach, or disclose the limitations of a software client operating on a second communication device to emulate simplex communication for communicating with a first communication device, Vatt ‘788 cannot support a § 102 rejection.

Because the dependent claims include all the limitations of the base independent claim and add further limitations to these claims, Applicant believes the rejection of dependent Claims 2, 4, 10-12, 15-18, and 20 is traversed. Dependent claims 15, 18, and 19 have been amended to correspond to amended independent Claim 14 but these amendments do not add any additional limitations. As such, all claims 1, 2, 4, 10-12, 14-18, and 20 rejected by the Examiner in light of Vatt '788 are believed allowable. Applicant requests reconsideration of these rejections in light of these remarks.

## **II. REJECTION OF CLAIMS 1-4, 9, 14, AND 16 AS AMENDED UNDER 35 U.S.C. § 103(a) IS IMPROPER**

The Examiner rejected Claims 1, 3, 4, 14, and 16 under 35 U.S.C. § 103(a) as allegedly being obvious and unpatentable over U.S. Patent 5,978,654 to Colwell et al (hereafter "Colwell '654"). Claims 1, 2, 3, and 9 were rejected under § 103(a) U.S. Patent 5,809,425 to Colwell et al. (hereafter "Colwell '425"). The Applicant believes the amended claims overcome the rejection, because the references do not teach, suggest, or disclose the claimed features the amended independent Claims 1 and 14. Applicant respectfully suggests that the Examiner's rejection based on Colwell '654 and Colwell '425 should be overcome by the present remarks

As discussed above, independent Claims 1 and 14 have been amended to clarify that the simplex communication protocol under the invention is emulated on a second communication device normally operating a different communication protocol to communicate with a first communication device through the use of a software client. Nothing in Colwell '654 or Colwell '425 teaches, suggests, or discloses emulating a simplex communication protocol using a software client to support communication

between two communication devices that normally, relative to each other, operate using different communication protocols. Because the cited references do not teach, suggest, or disclose these limitations, the § 103 rejection is believed to be traversed.

Because the rejection of the independent Claims 1 and 14 cannot be supported and each of the dependent claims includes all the limitations of the base claim, it is respectfully suggested that the Examiner's obviousness rejection of dependent claims 2-4, 9, and 16 is also traversed. As such, all claims (1-4, 9, 14 and 16) rejected in view of Colwell '654 and Colwell '425 are believed to be allowable, and Applicants request reconsideration of this rejection in view of these comments.

### **III. U.S. PATENT 6,373,437 TO MORNINGSTAR IS NOT PRIOR ART TO THE INVENTION**

If an Applicant can show that the claimed invention predates the filing date of a cited art United States patent, then that patent is not prior art and cannot be used to support a 35 U.S.C. §103 rejection. The application for U.S. Patent 6,373,437 to Morningstar (hereafter "Morningstar '437") was filed on December 7, 2000, and the subject application was filed on March 20, 2001. Claims 21-26 were rejected under §103 citing Morningstar '437.

As set forth in the attached declaration of Andrew Silver, the inventor, Mr. Silver conceived the invention prior to December 7, 2000. *Silver Declaration*, ¶ 2-5, p. 1-2. As part of the internal review and evaluation at Nortel (the assignee), a document entitled "Invention Disclosure Submission Reply" is submitted to appropriate review committee personnel. *Silver Declaration*, ¶ 4-5, p. 2. The first page of the Invention Disclosure Submission document is attached to Mr. Silver's declaration, and according to this

invention disclosure, the invention was conceived no later than February 4, 2000. *Silver Declaration*, ¶ 5, p. 2.

During the evaluation and review process, Mr. Silver continued to diligently work on further refinements to the claimed invention. *Silver Declaration*, ¶ 6, p. 2. The invention disclosure was ready for patent counsel to prepare the patent application no later than October 27, 2000 (predates Morningstar '437), the application was provided to patent counsel no later than November 17, 2000, and the application was diligently prepared for filing on March 20, 2000. *Silver Declaration*, ¶ 7, p. 2-3. The invention was formally reviewed no later than September 20, 2000 and had been demonstrated and shown to be both inventive and/or of commercial value to the company as of that date.

As such, constructive reduction to practice occurred no later than September 20, 2000 if it did not occur earlier by virtue of the development work by Mr. Silver. *Silver Declaration*, ¶ 7, p. 2-3. Because the invention was conceived and reduced to practice prior to the December 7, 2000 filing date of Morningstar '437, coupled with due diligence and reduction to practice before the filing date of Morningstar '437, the Applicant believes that the 35 U.S.C. §103(a) rejection based on Morningstar '473 has been traversed. *See* 37 C.F.R. §1.131(b).

#### **IV. CONCLUSION**

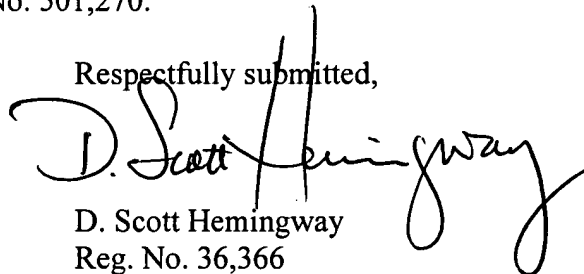
The Applicant respectfully requests reconsideration of the present application because the Examiner's 35 U.S.C. §§ 102(b) and 103(a) rejection are believed to have been traversed by the present Response. Certain claim elements required in the amended independent Claims 1 and 14 as well the dependent claims, are not set forth in the cited

prior art. As such, independent Claims 1 and 14 are believed to be allowable for the reasons discussed above. Claims 21-26 were rejected citing art that is shown not to be prior art, because the invention predates the cited reference. As such, Claims 21-26 are believed allowable.

Since the dependent claims add further limitations to the limitations of the allowable independent claims, the Applicant believes the dependent claims of Claims 1 and 14 are likewise allowable. Accordingly, pending Claims 1-28 are believed allowable because the claimed invention is not disclosed, taught, or suggested by the cited references.

It is believed that no additional fees are necessary for this filing. If additional fees are required for filing this response, then the appropriate fees should be deducted from D. Scott Hemingway's Deposit Account No. 501,270.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. Scott Hemingway", written over the typed name and registration information.

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## **AMENDMENTS TO THE DRAWINGS**

The Examiner stated that the drawings were “poor and the text illegible.” Formal drawings were submitted on March 4, 2002. On October 21, 2004, Applicant’s counsel contacted the draftsman for this application, Charles Fann, who stated that the formal drawings submitted on March 4, 2002 were acceptable, and that Applicant did not need to submit corrected drawings.